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09/877,409	06/07/2001	Bruce M. Ruana	RUANA-002	7700

7590

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EXAMINER

GUTMAN, HILARY L

ART UNIT

PAPER NUMBER

3612

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/877,409

Applicant(s)

RUANA, BRUCE M.

Examiner

Hilary Gutman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 1-14, 30-42 and 57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-22, 25-29, 43-49 and 52-56 is/are rejected.
- 7) ☒ Claim(s) 23, 24, 50 and 51 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 25.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities:

On page 2, line 15, "hanging" should be "hangings".

On page 11, the last paragraph (on line 16) is repetitive and should perhaps be deleted.

On page 12, lines 10-15 appear to be repetitive and confusing. Furthermore, the applicant should stick with either top/bottom surface or inner and outer surface but not both. Furthermore, the chosen phrase top/bottom or inner/outer by the applicant should be consistently maintained throughout the specification and claims for clarity. It should be noted that an inner surface and an outer surface are apparently recited in the claims.

On page 13, the first paragraph (lines 1-11) is repetitive and should perhaps be deleted. Also on lines 15, 16, 17, 19, and 20, reference number "130" should be "120" to correspond with the drawing figures.

On page 14, line 1, "130" should be "120" to correspond with the drawings.

Appropriate correction is required.

### *Claim Objections*

2. Claims 21, 23, and 49 are objected to because of the following informalities:

In claim 21, on line 2, "material" should be deleted.

In claim 23, line 3, "the length of a railing" should perhaps be "a length of the railing".

In claim 49, line 2, "material" should be deleted.

Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 15-16, 20-22, 25-28, 43-44, 48-49, and 52-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Reeves et al.

For claim 15, Reeves et al. disclose an advertising surface having a width and a length for affixing to a table, the surface comprising: a skin layer 19 having an outer surface and an inner surface, the outer surface having printed indicia forming a visual image (disclosed but not shown); a backing layer 15 having an outer surface and an inner surface of the skin layer; a 4-way stretchable material layer 29 with a stretchable outer surface and a stretchable inner surface, the outer surface of the stretchable layer adhered permanently to the inner surface of the backing layer; and the inner surface of the 4-way stretchable material layer having a layer of releasable adhesive 31 applied thereto.

For claim 43, Reeves et al. disclose an advertising system having a length and a width for presenting a visual image on a railing (not shown), the system comprising: a 4-way stretchable material layer 29 having an outer surface and an inner surface, the inner surface of the 4-way stretchable layer releasably adhered to a surface such as a tabletop or to the railing; a backing layer 15 having an outer surface an inner surface, the inner surface of the backing layer permanently attached to the outer surface of the stretchable layer; a skin layer 19 having an outer surface and an inner surface, the inner surface of the skin layer permanently attached to the outer

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surface of the backing layer, and the skin layer having printed indicia (disclosed but not shown) on the outer surface of the skin layer forming the visual image; and the skin layer, the backing layer and the 4-way stretchable material layer each having a width substantially similar to a circumference of the railing, such that edge of the skin layer, the backing layer and the 4-way stretchable material layer abut when wrapped around the railing.

The skin layer has a thickness of about 0.5 millimeter to about 2.5 millimeter. The skin layer can be polyurethane. The backing layer 15 can be paper. The surface has a width substantially equal to the circumference of the railing. It should be noted that railings are well known in the prior art and come in various shapes and sizes. Railings of the prior art can have various diameters and circumferences (if round) or various perimeters (non-circular shapes).

For claims 25-28 and 52-55, it should be noted that the patentability of a product does not depend on its method of production. If the product in the product-by-process claim, is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process (MPEP 2113).

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reeves et al. in view of Casteel et al.

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Reeves et al. disclose the skin layer comprising polyvinyl. Furthermore, the skin layer can be vinyl acetate, ethyl cellulose, or apparently a foamed material such as foamed neoprene. In addition, the skin layer may have either a textured surface or a smooth surface.

Reeves et al. lack the skin layer being expanded vinyl.

Expanded vinyl or expanded vinyl acetate is well known in the prior art since it is lighter and softer than polyurethane. Expanded vinyl is shown for example in the Casteel et al. reference which discloses a pliable, stretchable expanded vinyl plastic for a trim panel.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the skin layer of Reeves et al. be an expanded vinyl material as taught by Casteel et al. in order to provide an exterior surface for the invention that is soft, light, and stretchable.

7. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reeves et al. in view of the Dupont and Cutting Edge Inc. websites.

Reeves et al. disclose the stretchable layer 29 comprising plastic but lack the plastic being a polyester film.

The Dupont website teaches that polyester films were developed in the 1950s and find use in imaging and graphics. Additionally, the Cutting Edge Inc. website teaches that polyester films are strong and will not generally shrink or tear easily. Furthermore, polyester films have a high heat resistance and are dimensionally stable.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the stretchable layer of Reeves et al. to be a polyester film as taught by

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the well known prior art in order to provide a layer that is strong and will not shrink or tear easily.

*Allowable Subject Matter*

8. Claims 23-24 and 50-51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

23-24, 50-51 =

*Response to Arguments*

9. Applicant's arguments with respect to claims 15-29 and 43-56 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hilary Gutman whose telephone number is 703-305-0496. The examiner can normally be reached on M-F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on 703-308-3102. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1134.

12. **Any response to this action should be mailed to:**

Assistant Commissioner for Patents

Washington, D.C. 20231

**or faxed to:**

(703) 872-9326, (for formal communications intended for entry)

**or:**

(703) 746-3515, (for informal or draft communications, please clearly label

"PROPOSED" or "DRAFT").

hlg  
December 10, 2003

*Henry Gutman*  
Henry GUTMAN  
3612  
12/10/03